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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,302	09/10/1999	ARA HOVANESSIAN	03495.0166-0	2522

22852 7590 04/15/2003

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EXAMINER

ZEMAN, ROBERT A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 04/15/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/393,302

Applicant(s)

HOVANESSION ET AL.

Examiner

Robert A. Zeman

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 2,4-6,9,10,13 and 24.

Claim(s) withdrawn from consideration: 1,7,8,11,12 and 14-23.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **ADVISORY ACTION**

The period for reply continues to run 3 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed 3-21-2203 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

The proposed amendment raises new issues that would require further consideration and/or search. Minimally, said amendment raises new issues under 35 U.S.C. 112, second paragraph.

The proposed amendment presents additional claims without canceling a corresponding number of finally rejected claims.

### ***Objections Maintained***

The objection to the drawings outlined on the PTO-948 form attached to the previous Office action is maintained. Applicant states in his response that corrected drawing were attached to said response (Paper No. 25). To date, no corrected drawings have been received.

Art Unit: 1645

The objection to claims 6, 9-10, 13 and 24 as being in improper multiple dependent form is maintained for reasons of record since the amendment has not been entered. It appears that the proposed amendment, if entered, would have been sufficient to overcome said objection.

***Claim Rejections Maintained***

***35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 2, 4-6, 9-10, 13 and 24 under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification is maintained for reasons of record. Applicant's arguments are predicated on amended claims not of record and hence are deemed non-persuasive.

**Applicant argues:**

1. The limitation "fragment of extracellular or cytoplasmic P95/Nucleolin" is supported in Figure 22.
2. Since P95/nucleolin is a receptor for HIV and HIV infects by fusion of viral and cellular membranes, said receptor must be on the surface of the cell.
3. The specification describes P95/nucleolin as being expressed on the cell surface.
4. Claim 2 has been amended to remove the objected to limitation.

Art Unit: 1645

Applicant's arguments have been fully considered and deemed non-persuasive. While the specification supports membrane bound P95 nucleolin, there is no support for intracellular (cytoplasmic) or cell free (extracellular) nucleolin.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 2, 4-6, 9-10, 13 and 24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained for reasons of record. Applicant's arguments are predicated on the entry of the proposed amendment. Since said amendment has not been entered, Applicant's arguments are not directed the pending claims. Moreover, Applicant has not responded to the rejection of claim 4 outlined in the previous Office action.

### ***35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 1645

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 2, 4-6, 9-10, 13 and 24 under 35 U.S.C. 103(a) as obvious over Srivastava et al. (FEBS Letters, Vol. 250, No. 1, pages 99-105, 1989) is maintained for the reasons of record. Applicant's arguments are predicated on amended claims not of record and hence are deemed non-persuasive.

The rejection of claims 2, 4-6, 9-10, 13 and 24 are rejected under 35 U.S.C. 103(a) as obvious over Rankin et al. (Nucleic Acids Research, Vol. 21 No. 1, page 169) is maintained for the reasons of record. Applicant's arguments are predicated on amended claims not of record and hence are deemed non-persuasive.

#### ***Claim Rejection Withdrawn***

The rejection of claims 2, 4, 6, 9-10, 13 and 24 under 35 U.S.C. 102(a) as being anticipated by or in the alternative, under 35 U.S.C. 103(a) as obvious over Callebaut et al. (Virology, Vol. 218 No.1, pages 181-192, 1996) is withdrawn. Applicant's arguments have been fully considered and deemed persuasive.

#### ***Conclusion***

No claim is allowed.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991.

The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Robert A. Zeman  
April 10, 2003

  
**LYNETTE R. F. SMITH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**